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In re Application of: :
Duft et al. :
Serial No.: 09/445,517 : PETITION DECISION
Filed: June 5, 1997 :
Attorney Docket No.: 235/013US :

This is in response to the petition under 37 CFR § 1.181(a), filed April 13, 2009, requesting that at least one of the grounds of rejection designated as sections C, E, F, G, and H in the Examiner's Answer of February 13, 2009 be designated a new grounds of rejection.

BACKGROUND

Pertinent portions of the prosecution history are set forth herein.

On May 30, 2006, the examiner mailed to applicants a final Office action containing the following rejections:

- 42) Claims 23, 24, 27, 29-31, 33, 34, 37-39, and 80-82 were rejected under 35 USC 102(b) as being anticipated by Kolterman et al. (WO 96/40220) as evidenced by Tsanev (Vutr. Boles 23:12-17, 1984, abstract),
- 29) Claims 23, 24, 33, and 34 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 34 and 35 of US 5686411 (Gaeta et al.) as evidenced by Tsanev (Vutr. Boles 23:12-17, 1984, abstract), and
- 30) Claims 23 and 33 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11 and 13 of US 5321008 (Beumont et al.) as evidenced by Tsanev (Vutr. Boles 23:12-17, 1984, abstract) and Rink et al. (US 5739106).

On November 30, 2006, applicants submitted a request for continued examination accompanied by an amendment containing arguments addressing the rejections noted above.

On April 23, 2007, the examiner mailed to applicants a non-final Office action containing the following grounds of rejections:

- 39) Claims 23, 24, 27, 29, 31, 33, 34, 37-39, 80, and 82 were rejected under 35 USC 102(b) as being anticipated by Kolterman et al. (WO 96/40220) as evidenced by Tsanev (Vutr. Boles 23:12-17, 1984, abstract),
- 42) Claims 23, 24, 27, 29, 33, 34, 37, and 38 were rejected under 35 USC 102(e)(2) as being anticipated by Beumont et al. (US 5321008) as evidenced by Tsanev (Vutr. Boles 23:12-17, 1984, abstract),
- 40) Claims 23, 24, 29, 33, 34, and 38 were rejected under 35 USC 102(e)(2) as being anticipated by Gaeta et al. (US 5686411) as evidenced by Tsanev (Vutr. Boles 23:12-17, 1984, abstract),
- 34) Claims 23, 24, 33, and 34 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 34 and 35 of US 5686411 (Gaeta et al.) as evidenced by Tsanev (Vutr. Boles 23:12-17, 1984, abstract), and
- 35) Claims 23 and 33 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11 and 13 of US 5321008 (Beumont et al.) as evidenced by Tsanev (Vutr. Boles 23:12-17, 1984, abstract) and Rink et al. (US 5739106).

On October 23, 2007, applicants submitted an amendment containing arguments addressing the rejections noted above.

On February 11, 2008, the examiner mailed to applicants a final Office action containing the following rejections:

- 26) Claims 23, 24, 27, 29, 31, 33, 34, 37-39, 80 and 82 were rejected under 35 USC 102(b) as being anticipated by Kolterman et al. (WO 96/40220) as evidenced by Tsanev (Vutr. Boles 23:12-17, 1984, abstract),
- 29) Claims 23, 24, 27, 29, 33, 34, 37, and 38 were rejected under 35 USC 102(e)(2) as being anticipated by Beumont et al. (US 5321008) as evidenced by Tsanev (Vutr. Boles 23:12-17, 1984, abstract),
- 27) Claims 23, 24, 28, 33, 34, and 38 were rejected under 35 USC 102(e)(2) as being anticipated by Gaeta et al. (US 5686411) as evidenced by Tsanev (Vutr. Boles 23:12-17, 1984, abstract),
- 21) Claims 23, 24, 27, 29, 33, and 34 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 34 and 35 of US 5686411 (Gaeta et al.) as evidenced by Tsanev (Vutr. Boles 23:12-17, 1984, abstract), and
- 22) Claims 23 and 33 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11 and 13 of US 5321008 (Beumont et al.) as evidenced by Tsanev (Vutr. Boles 23:12-17, 1984, abstract) and Rink et al. (US 5739106).

On May 12, 2008,, applicants submitted an after final amendment containing arguments addressing the rejections noted above.

On May 28, 2008, the examiner mailed to applicants an advisory action containing the following rejections:

- 14) Claims 23, 24, 27, 29, 31, 33, 34, 37-39, 80, and 82 were rejected under 35 USC 102(b) as being anticipated by Kolterman et al. (WO 96/40220) as evidenced by Tsanev (Vutr. Boles 23:12-17, 1984, abstract),
- 17) Claims 23, 24, 27, 29, 33, 34, 37, and 38 were rejected under 35 USC 102(e)(2) as being anticipated by Beumont et al. (US 5321008) as evidenced by Tsanev (Vutr. Boles 23:12-17, 1984, abstract),
- 15) Claims 23, 24, 29, 33, 34, and 38 were rejected under 35 USC 102(e)(2) as being anticipated by Gaeta et al. (US 5686411) as evidenced by Tsanev (Vutr. Boles 23:12-17, 1984, abstract),
- 11) Claims 23, 24, 33, and 34 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 34 and 35 of US 5686411 (Gaeta et al.) as evidenced by Tsanev (Vutr. Boles 23:12-17, 1984, abstract), and
- 12) Claims 23 and 33 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11 and 13 of US 5321008 (Beumont et al.) as evidenced by Tsanev (Vutr. Boles 23:12-17, 1984, abstract) and Rink et al. (US 5739106).

On October 29, 2008, appellants submitted an appeal brief containing arguments addressing the rejections noted above

On January 29, 2009, the examiner mailed to appellants a communication containing a full certified English translation of the Tsanev reference.

On October 29, 2008, the examiner mailed to appellants an examiner's answer containing the following rejections:

- C) Claims 23, 24, 27, 29, 31, 33, 34, 37-39, 80, and 82 were rejected under 35 USC 102(b) as being anticipated by Kolterman et al. (WO 96/40220) as evidenced by Tsanev (Vutr. Boles 23:12-17, 1984),
- E) Claims 23, 24, 29, 33, 34, and 38 were rejected under 35 USC 102(e)(2) as being anticipated by Gaeta et al. (US 5686411) as evidenced by Tsanev (Vutr. Boles 23:12-17, 1984),
- F) Claims 23, 24, 27, 29, 33, 34, 37, and 38 were rejected under 35 USC 102(e)(2) as being anticipated by Beumont et al. (US 5321008) as evidenced by Tsanev (Vutr. Boles 23:12-17, 1984),
- G) Claims 23, 24, 33, and 34 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 34 and 35 of US 5686411 (Gaeta et al.) as evidenced by Tsanev (Vutr. Boles 23:12-17, 1984), and
- H) Claims 23 and 33 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11 and 13 of

US 5321008 (Beumont et al.) as evidenced by Tsanev (Vutr. Boles 23:12-17, 1984).

On April 13, 2009, appellants submitted the instant petition, requesting that those rejections relying upon Tsanev as evidence be designated new grounds of rejection in view of the new, full certified English translation of the Tsanev reference. On the same date, appellants submitted a reply brief addressing the contents of the new, full certified English translation of the Tsanev reference.

On April 30, 2009, the examiner mailed to appellants a communication indicating that the reply brief had been entered and the contents noted. The application was forwarded to the Board of Appeals and Interferences.

DISCUSSION

The petition and the file history have been carefully considered.

In the petition, applicants argue that the full certified English translation of the Tsanev reference (referred to in the petition as the "Scientific Paper") was first used in the examiner's answer, and thus the grounds of rejection relying on Tsanev et al. should be designated new grounds of rejection. Appellants argue that the rejections in the examiner's answer rely on portions of the Scientific Paper outside of the abstract. Appellants further argue that the Scientific Paper is dissimilar to the abstract. Appellants urge that the new, detailed disclosure in the Scientific Paper provides new facts and a new basis for the rejections. As examples, appellants point to the term "age type diabetes" found in the abstract but not in the Scientific Paper, and the term "overweight" in the abstract being different from "above-normal weight" in the Scientific Paper. Appellants urge that the Scientific Paper provides new facts, matters, and issues not found in the abstract and thus provides a different basis and grounds for the rejections at issue in this petition. Appellants also urge that, since the Scientific Paper was entered after appellant's appeal brief, appellants have not been provided with a fair opportunity for consideration and/or response to the teachings of this reference.

MPEP § 706.02(II) states:

Prior art uncovered in searching the claimed subject matter of a patent application often includes English language abstracts of underlying documents, such as technical literature or foreign patent documents which may not be in the English language. When an abstract is used to support a rejection, the evidence relied upon is the facts contained in the abstract, not additional facts that may be contained in the underlying full text document.

In the instant case, the examiner has consistently referred to the abstract of Tsanev in the rejections, which abstract is only relied upon as evidence of inherency, and not other portions of the Scientific Paper. Therefore, the examiner's answer does not contain new grounds of rejection based on the Scientific Paper.

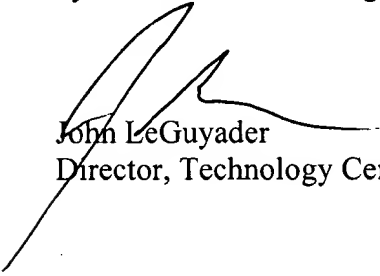
DECISION

The petition is subsequently **DENIED**.

However, a revised Examiner's Answer will be forthcoming that clearly relies only on the abstract.

Any new or renewed petition must be filed within TWO MONTHS of the mail date of this decision.

Should there be any questions about this decision please contact Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 703-872-9306.



John LeGuyader
Director, Technology Center 1600